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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/484,437    01/18/00    JIANG

T    M4065.0226/P

MM21/0925  
Dickstein Shapiro Morin & Oshinsky LLP  
2101 L Street NW  
Washington DC 20037-1526

EXAMINER
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MITCHELL, J

ART UNIT	PAPER NUMBER
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2822

DATE MAILED: 09/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

**Application No.**

09/484,437

**Applicant(s)**

JIANG, TONGBI

**Examiner**

James Mitchell

**Art Unit**

2822

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 18 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 21-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This office action is in response to the application filed January 18, 2000.

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-20 drawn to a device, classified in class 257, subclass 783.
  - II. Claims 21-19 drawn to a process of manufacture, classified in class 438, subclass 118.
3. The inventions are distinct, each from the other because of the following reasons:
4. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process. For example, the attachment of a device to a substrate with an adhesive that is cured above 100° C.
5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37

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CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. During a telephone conversation with Bill Pau on September 19, 2001 a provisional election was made without traverse to prosecute the invention of group I., claims 1-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

8. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-6,9-16,19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art (APA).

11. The admitted prior art discloses a solder mask (18) with contact (22) and a die (12) with a contact (20) wherein the contact are in contact by a wire (28), said contact free from contaminants of adhesive (14) via the physical separation.

12. In regard to claims 1-6,9-17,19 and 20, a method of making characteristic is given no patentable weight in determining patentability of the final device structure. Note that a "product by process" claim is directed to the product per se, no matter how actually made. *In re Thorpe*, 227 USPQ 964 (Fed.Cir.1985). Case law makes it is clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, not the patentability of the process, and that an old or obvious product produced by a new method is not a patentable product, whether claimed in "product by process" or not.

13. Claims 7,8,17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art (APA) in view of Dershem et al. (U.S 6,034,194).

14. The prior art (APA) discloses the elements stated in paragraph 5.

15. APA does not disclose said adhesive comprising Bismaleimide (BMI), however Dershem utilizes an adhesive comprising BMI for attachment of a die (Lines 1-7, Column 1).

16. It would have been obvious to one of ordinary skill in the art to form the adhesive of the admitted prior art with a BMI material in order to provide good adhesion to the device and the attached substrate as taught by Dershem (abstract).

### **Conclusion**

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schrock (U.S 6,221,691).

The prior art discloses in Schrock the use of BMI as an adhesive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mitchell whose telephone number is (703) 305-0244. The examiner can normally be reached on M-F 10:30-8:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead Jr. can be reached on (703) 308-4083. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3432 for regular communications and (703) 305-3230 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

jmm  
September 19, 2001

  
**CARL WHITEHEAD, JR.**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2800**